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32997 7590 12/09/2008
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EXAMINER

FISCHER, ANDREW J

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3621

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/560,785
Filing Date: April 28, 2000
Appellant(s): CLARK ET AL.

Randy W. Tunj
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 10/02/2007 appealing from the Office action mailed 05/13/2003.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct. A new grounds of rejection is contained in this Examiner's Answer.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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U.S. Pat. No. 5,646,862 Jolliffe et al. 07/1997

U.S. Pat. No. 6,272,472 Danneels et al 08/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor (s), at the time the application was filed, had possession of the claimed invention.

In claim 13, the phrase "creating an information template having a dynamically configurable and searchable field..." is considered new matter. The Examiner recognizes that according to the originally filed specification, "the supplier search may be done at substantially the same time as the attributes are created within step 18". Originally filed specification, page 8, lines 13-16. Creating the attributes appears to mean creating the content of the searchable fields.

Moreover, it appears the "template" corresponds to the supplier and not the attributes (see., e.g. amended claim 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 13-16 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Johnson et al (U.S. Pat. No. 6,023,683) in view of Jolliffe et al (U.S. pat. No. 5,646,862).

As per claims 1-5 and 13-16, Johnson discloses the claimed method including identifying a plurality of suppliers (the set of suppliers in the "different suppliers", col 4, lines 47), creating an information template for each supplier (the template fields passed via data interface 60 comprising all or a subset of the twelve fields, col 5, line 65-col 6, line 3), specifying a product and each component within the product (inherent), searching (via 50) each of the information templates for the specified component (searching for the desired component by e.g. part number and creating hit list 47) and thus identifying a particular supplier from the plurality of suppliers, causing a design file to be created (the hit list), transmitting at least one computerized design file associated with each component disposed within said product, selectively utilizing the design file of the component to be created (a catalog image), purchasing the product from the identified supplier (ordering items from the order list after inventory sourcing), placing certain information on the information template related to the cost of producing the product (the product "list price"), storing the created image in a database, evaluating the design file before purchasing (the user can

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scroll through the hit list 47 and view an image, col 10, lines 65-col 11, lines 2), creating information relating to the operation of the product (the product number) and placing it within the template, a file server 200, a local personal computer 220, fixing attributes of the product (list price, description, etc), and the time required to provide a product or component (the availability). Johnson 683" also discloses that the information template has a dynamically configurable and searchable field (the searcher can determine which fields to search during the search (dynamically configurable) and the values within the field itself is searchable (searchable field). Johnson 683" does not directly disclose creating a three dimensional prototype of a product. However, Jolliffe teaches that in a vendor-neutral automobile system the concept of creating a three dimensional image in a CAE system for design products and components (col 5, line 65-col 5, line 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson 683" as taught by Jolliffe to include creating a three dimensional prototype of the component or product. Such a modification would have helped permit mass communication between different designs in a vendor-neutral system. As noted in the previous Office Action, it is again the Examiner's principle position that since Johnson 683" discloses searching by product number, and the product could be a subset of a larger assembly, Johnson 683" inherently discloses searching with templates by both product and component such as in auto parts. In fact, noting in Johnson 683" prevents the parts disclosed from being auto parts. Furthermore, while one product number could refer to a product, the next product number could just as easily (and most likely does) refer to a component within an assembly or larger product. Therefore, the 'decomposing said product into several interconnected components" is inherent since the part number would already reflect this decomposition.

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Functional recitations using the word “for” (e.g. ‘for purchasing a product’ as recited in claim 1) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulation difference in the steps of the claim..).

Claims 6 and 7, as understood by the examiner, are rejected under 35 U.S.C 103 (a) as being unpatentable over the Johnson 683”/Jolliffe combination in further view of Danneels et al (U.S. 6,272,472 B1) (“Danneels”). The Johnson 683/Jolliffe combination discloses as discussed above but do not directly disclose the global computer network as the Internet. Danneels teaches the concept of using the Internet as a buyer/seller communications medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson 683” as taught by Danneels to include using the Internet to do the product searching. More and more platforms are moving from proprietary networks to internet based systems because most companies already maintain Internet based connections. By replacing their older systems with Internet based systems, the overall costs of the system is decreased and the system is easier to maintain.

Since Applicants did not seasonably traverse (or inadequately traversed) the Official Notice statement (s) as stated in the previous Office Action, the Official Notice statement (s) are taken to be admitted prior art. See MPEP 2144.03.

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The Examiner notes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked, Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. 1.111 (b) (i.e. Applicants have not argued lexicography is invoked). To further support the Examiner's position that Applicants are not their own lexicographer, it is the Examiner's factual determination that not only have Applicants failed to point to definitional statements in their specification or prosecution history, Applicants have also failed to point to a term or terms in a claim with which to draw in those statements. Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer. Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome, the claims therefore continue to be interpreted with their broadest reasonable interpretation standard.

NEW GROUND(S) OF REJECTION

Claims 1-7 and 13-16 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent¹ and recent Federal

¹ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (*en banc*).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

Here, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. Independent claim 1 merely recites identifying, creating, a product, searching, identifying, causing, transmitting, selectively, purchasing - none of which are tied to a statutory class of matter, or involve a transformation of subject matter to a different state or thing. Independent claim 13 merely recites fixing, decomposing, identifying, creating a template, and searching - none of which are tied to a statutory class of matter, or involve a transformation of subject matter to a different state or thing.

(10) Response to Argument

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In response to Applicants arguments filed on 10/02/2007, Applicants argue that none the references cited, either alone or in combination discloses:

- a. defining the information template associated with each supplier and with each product.

As indicated above, it is the Examiner's principal position that Johnson discloses this limitation in col 5, line 65-col 6, line 3, specifically, the template fields passed via data interface 60 comprising all or a subset of the twelve fields specifying a product and each component within the product (inherent), searching (via 50) each of the information templates for the specified component (searching for the desired component by e.g. part number and creating hit list 47).

- b. Applicants continue to argue that Jolliffe and Johnson do not teach a 3-D prototype design of a product. However, the Examiner respectfully disagrees with this assertion since Johnson 683" does not directly disclose creating a three dimensional prototype of a product. However, Jolliffe teaches that in a vendor-neutral automobile system the concept of creating a three dimensional image in a CAE system for design products and components (col 5, line 65-col 5, line 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson 683" as taught by Jolliffe to include creating a three dimensional prototype of the component or product. Such a modification would have helped permit.

- c. Applicants further argue that the Danneels reference does not teach a global computer network as the Internet. As noted above, the Johnson 683/Jolliffe combination do not directly disclose the global computer network as the Internet. Danneels teaches the concept of using the Internet as a buyer/seller communications medium.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson 683" as taught by Danneels to include using the Internet to do the product searching. More and more platforms are moving from proprietary networks to internet based systems because most companies already maintain Internet based connections. By replacing their older systems with Internet based systems, the overall costs of the system is decreased and the system is easier to maintain.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth

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in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).


Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Christopher Johns

Examiner

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Vincent Millio

Appeals
PRACTICE
SPECIALIST



ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

